<u>REMARKS</u>

Claims 8, 19, 22, 23, 38, 42, 43, 48 and 51 have been canceled. New claim 55 has been added. Claims 1-7, 9-18, 20, 21, 24-37, 39-41, 44-47, 49, 50 and 52-55 are now pending in this application.

<u>Rejection under 35 USC §101</u>

Claims 25-36 and 52-54 are rejected in that the terms "trusted party" and "presenter" have been interpreted to include human beings. Claims 25 and 52 have been amended to recite a "presenter computer" (Figure 1, 708 and page 7, lines 13-14), a "trusted party computer" (access control server 712 of trusted party 710) and an "acceptor computer" (718, page 10, line 7). Therefore, it is requested that this rejection be withdrawn.

<u>Rejection under 35 USC §112, first paragraph</u>

The Office action has suggested that the limitation of a "trusted party computer" and the various method steps performed by this computer are not disclosed in the specification. Figure 1 shows a trusted party that includes an access control server (ACS) 712. Page 7, line 24 describes the ACS as a computer system. Lines 14-26 of this page also describe the method steps performed by this trusted party computer. In addition, Figure 1 shows messages 2, 3 and 6-8 passing back and forth between the access control server computer and other computers in the system. Page 10, line 22 through page 15, line 19 discuss the method steps being performed by the access control server computer (which is included within the trusted party).

Applicant notes that the limitation of "in real time" is supported in the provisional application filed September 10, 2002. Support for the inventive technique being performed in "real time" can be found at page 15 (final paragraph), page 16 (first full paragraph), and page 22 (first and third paragraphs). Applicant therefore requests that these rejections be withdrawn.

<u>Rejection under 35 USC §112, second paragraph</u>

The Office action suggests that it is unclear whether the claims in the application are directed toward an enrollment process or an online transaction. The examiner is correct to interpret the method claims to include both the enrollment process and the authentication of the online transaction. Claims 1 and 37 require that the first three steps occur during an enrollment process; Applicant has amended these claims require that the fourth step occur "<u>during said on-</u>

line transaction after said enrollment process" to make clear the difference between the enrollment process and the online transaction. One of skill in the art upon reading the specification will understand that the subsequent steps also occur during the online transaction. The preamble of claims 1 and 37 do recite a method of either validating or providing profile data during an online transaction (and that is what the method does), even though the method does include preliminary steps involving an enrollment process. Applicant submits that this wording of the preamble does not render these claims confusing, although Applicant is willing to delete the phrase "during an online transaction" from the preamble if necessary.

Claims 25 and 52 are system claims that clearly describe which limitations are present during an enrollment process and which limitations are present during the online transaction. There is no preamble similar to the method claims and Applicant submits that these system claims are not confusing and requests that the rejection be withdrawn.

Rejection under 35 USC §102

The Office action has rejected the claims under §102(e) as being anticipated by *Dominguez et al.* (*Dominguez*), U.S. publication No. 2004/0059688, application No. 10/660,263. But, this reference is nothing more than the publication of the present application. A reference cannot be cited as prior art against itself. It is requested that this rejection be withdrawn.

Rejection under 35 USC §103

The Office action has rejected claims 1 and 25 under §103 as being obvious in view of *Carrott et al.* (*Carrott*), *Tsuei et al.* (*Tsuei*) and *Sipman et al.* (*Sipman*). Although the Examiner's arguments have been carefully considered, Applicant respectfully traverses this rejection as explained below.

Claim 1 requires fourth and fifth steps of receiving and comparing submitted profile data against profile data already stored by the trusted party. This submitted profile data has been received from the acceptor (which in turn received it from the presenter) which is trying to verify if this submitted profile data is correct. The sixth and seventh steps require receiving and authenticating the authentication data from the presenter. A valid authentication would tend to indicate that the true presenter has submitted the submitted profile data. Finally, the eighth step requires that the trusted party validate the submitted profile data using these results. In other words, the trusted party validates that the submitted profile data matches the stored profile data

and that the submitted authentication data matches with the authentication data. These steps occur during the online transaction and are closely related.

The Office action alleges that the fourth and fifth steps are disclosed in *Carrott* and that the sixth and seventh steps are disclosed in *Tsuei*. The action then alleges that the eighth step is disclosed in *Sipman*. Because these fourths through eighth steps are closely related, trying to find all of them in three different references yields unworkable results.

Firstly, even though *Carrott* might disclose in column 2 that customer information is given to a merchant in the transaction and then forwarded to a financial institution, that financial institution is <u>not</u> authenticating the customer during that same transaction. The Office action relies upon *Tsuei* as disclosing authentication in general during a transaction. But, these fourth through seventh steps require that authentication of the presenter (*e.g.*, the customer) occur <u>during the same transaction</u> in which the submitted profile data is received and compared. *Tsuei* does not disclose any authentication of the customer during the same transaction in which submitted profile data of the customer is received and compared.

Secondly, the Office action alleges at page 9 that *Sipman* discloses the eighth step of:
validating, by said trusted party, said submitted profile data using results of said comparing and results of said authenticating.

Thus, in order to validate the submitted profile that the acceptor has received from the presenter, this step requires not only that the trusted party make a determination that the submitted profile data is the same as the profile data that is stored, <u>but also</u> that the submitted authentication data from the presenter is the same as the authentication data established during the enrollment process. *Sipman* does not disclose this step and its requirements.

Sipman does show in Figure 4 that a transaction server holds a profile of a first party 33 and a profile of a second party 34. But, importantly, a profile of one party is never divulged to the other party. The profile of the first party is stored by the transaction server and is used <u>by the transaction server</u> to authenticate the first party during a transaction (column 7, lines 16-20). By contrast, the eighth step of claim 1 requires that the trusted party validate the submitted profile using the results of the fifth comparing step; in other words, the trusted party must validate that the submitted profile data is the same as the profile data it has stored. Thus, the trusted party validates that the submitted profile data received from the acceptor (having been previously received from the presenter during the transaction) is the same as the profile data that the

presenter sent to the trusted party during enrollment. Assuming for the sake of argument that the first party of *Sipman* is analogous to the presenter and that the second party is analogous to the acceptor, *Sipman* is not comparing stored profile data of the first party with submitted profile data from the second party. *Sipman* is comparing stored profile data of the first party with submitted profile data from the first party. In other words, the first party sends its own profile data to the transaction server to be compared against its own profile data which had previously been stored. The first party of *Sipman* does not send its profile data to the second party, so that the second party can then submit the profile data to the transaction server to be compared against the stored profile data of the first party. The eighth step of claim 1 requires that the submitted profile data is validated by comparing stored profile data of the presenter with submitted profile data that has come from the acceptor.

For this reason, it is requested that rejection of claim 1 be withdrawn. Claim 25 includes similar limitations and is believed patentable for the same reasons.

Rejection under 35 USC §103

The Office action has rejected claims 37 and 52 under §103 as being obvious in view of *Carrott et al.* (*Carrott*), *Tsuei et al.* (*Tsuei*) and *Sipman et al.* (*Sipman*). Although the Examiner's arguments have been carefully considered, Applicant respectfully traverses this rejection as explained below.

Claim 37, as pointed out in the previous reply, requires in the fourth step that the acceptor ask the trusted party to provide the profile data of the presenter, and in the seventh step that the trusted party provide this profile data to the acceptor. The Office action has cited *Sipman*. But, as explained above, *Sipman* in Figure 4 only discloses that the transaction server holds the profile of the first party and the profile of the second party. The transaction server does not give the profile of one party to the other party. In particular, the second party is not asking the transaction server to provide the profile 33 of the first party, and the transaction server does not provide the profile 33 of the first party to the second party. The first party might fill in a form, but this is not a first-party profile that the transaction server provides to the second party.

For this reason, it is requested that rejection of claim 37 be withdrawn. Claim 52 includes similar limitations and is believed patentable for the same reasons.

<u>Dependent Claims</u>

Since the dependent claims depend from the independent claims, it is respectfully submitted that they are each patentable over the art of record for at least the same reasons as set forth above with respect to the independent claims. Further, each of the dependent claims require additional features that when considered in light of the claimed combination further distinguish the claimed invention from the art of record.

For example, claims 9, 29, 44 and 55 require a program identity number that allows the trusted party to match up the submitted profile data from the acceptor with the stored profile data originally submitted by the presenter during enrollment. The Office action has cited *Tsuei*, but this reference does not disclose that a program identity number is correlated with profile data and authentication data received by the trusted party computer, nor that the program identity number is received by the trusted party from the acceptor during the online transaction. It is requested that the rejection of these claims be withdrawn.

Reconsideration of this application and issuance of a Notice of Allowance at an early date are respectfully requested. If the Examiner believes a telephone conference would in any way expedite prosecution, please do not hesitate to telephone the undersigned at (612) 252-3330.

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